



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/632,492	07/31/2003	Jeffrey A. Arndt	10/632492	4396

7590 05/26/2005

Felix J. Sahlin  
1480 Mississippi River Boulevard S.  
St. Paul, MN 55116-1853

EXAMINER
----------

OUELLETTE, JONATHAN P

ART UNIT	PAPER NUMBER
----------	--------------

3629

DATE MAILED: 05/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/632,492

Applicant(s)

ARNDT ET AL.

Examiner

Jonathan Ouellette

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 31 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Objections*

1. Claims 17-24, 26, 33 and 35 are objected to because of the following informalities: Claims 17-24 and 35 contain the word "imputing" which should be changed to "inputting", and Claims 17, 20-23, 26, and 33 contain grammatical errors at the end of each claim. Appropriate correction is required.

### *Claim Rejections - 35 USC § 101*

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-13, 37 and 39-42 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

4. As an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof." Therefore, a

fundamental premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that promote the progress of "science and the useful arts". The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first test of whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

5. Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).
6. This "two prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI). See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held that the recited mathematical algorithm did not render the claim as a whole non-statutory using the Freeman-Walter-Abele test as applied to *Gottschalk v. Benson*, 409 U.S. 63, 175 USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the claimed subject matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. *In re Toma* at 857.

7. In *Toma*, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.
8. The decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* never addressed this prong of the test. In *State Street Bank & Trust Co.*, the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See *State Street Bank & Trust Co.* at 1374. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "[w]hether the patent's claims are too broad to be patentable is not to be judged under §101, but rather under §§102, 103 and 112." See *State Street Bank & Trust Co.* at 1377. Both of these analysis goes towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, *State Street* abolished the Freeman-Walter-Abele test used in *Toma*. However, *State Street* never addressed the second part of the analysis, i.e., the "technological arts" test established in *Toma* because the

Art Unit: 3629

invention in *State Street* (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under the *Toma* test. This dichotomy has been recently acknowledged by the Board of Patent Appeals and Interferences (BPAI) in affirming a §101 rejection finding the claimed invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

9. **Claims 1-13, 37 and 39-42** appear to be describing a method that is attempting to sell a background verification service, wherein a registrant/user submits profile information and the service verifies the submitted information and save the information for future proof/dissemination of verified user information. Thus, this process does not include a distinguishable apparatus, computer implementation, or any other incorporated technology, and would appear to be an attempt to patent an abstract idea not a “tangible” process and, therefore, non-statutory subject matter.
10. As to technological arts recited in the preamble, mere recitation in the preamble (i.e., intended or field of use) or mere implication of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract idea unless there is positive recitation in the claim as a whole to breathe life and meaning into the preamble.
11. Finally, mere intended or nominal use of a component, albeit within the technological arts, does not confer statutory subject matter to an otherwise abstract idea if the component does not apply, involve, use, or advance the underlying process.

Art Unit: 3629

12. In the present case, independent claim 1 describes posting the applicant's personal profile in a database, however, since the claim does not describe the use of a computer or other automated structure, the database could be considered a catalog or other form of manual information storage. Furthermore, the process of saving information to a database fails to automatically manipulate the data in order to advance the underlying process, and would thus be considered a nominal use of technology.

*Claim Rejections - 35 USC § 112*

13. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

14. **Claims 34, 37, 38, and 42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**
15. Claim 34 recites the limitation "the digitized photograph of the applicant" as claimed in claim 30. There is insufficient antecedent basis for this limitation in the claim.
16. Claim 37 recites the limitation "a data processing system for verification of an individual's identity" in the method described in claim 8. There is insufficient antecedent basis for this limitation in the claim.
17. Claim 38 recites the limitation "a data processing system for verification of an individual's identity" in the method described in claim 15. There is insufficient antecedent basis for this limitation in the claim.

Art Unit: 3629

18. Claim 42 recites the limitation "a data processing system for verification of an individual's identity" in the method described in claim 12. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

19. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

20. **Claims 1, 2, 9, 12, 14-24, 28-30, 35, 36, 42 and 43 are rejected under 35 U.S.C. 102(e) as being anticipated by Shapiro et al. (US 6,714,944 B1).**

21. As per **independent Claim 1**, Shapiro discloses a method for verification of an individual's identity comprising: a. entering identifying background information by the applicant (Fig.2, Registrant enters site and registers data); b. assigning a unique identifier to the applicant's personal profile (Abstract); c. verifying the validity of applicant's the background information (Fig.2, Verification Process); d. sorting and categorizing the verified data for review by the applicant (Fig.5B, Master Verification Document created); e. matching the applicant's verified personal data with the applicant (Fig.5A-5B, create Master Verification Document; C7 L58-65), f. review of the verified data by the applicant for accuracy (Fig.6A, Registrant reviews MVD before dissemination); g. creating a personal profile by the



Art Unit: 3629

- applicant using the verified data (Fig.5A-5B, Master Verification document); h. posting applicant's personal profile in a database (Fig. 5B, MVD filed in master storage); i. issuance of an invitation by applicant to a third party to view applicant's personal profile (Abstract, registrant communicates access information to a third party).
22. As per Claim 9, Shapiro discloses wherein applicant's background information is verified by one or more third party sources (C1 L61-63, C2 L8-11, C6 L35-54).
23. As per Claim 12, Shapiro discloses wherein the applicant's verified identification data may be accessed on a restricted basis for the applicant to verify or challenge its accuracy (C9 L7-23, registrant can review the MVD before dissemination, but can not directly change the MVD)
24. As per Claim 14, Shapiro discloses wherein the applicant's does not have direct dynamic access to their personal profile but can only modify a separate data table joined to their data table by data query for output and display purposes by a unique member identifier (C8 L59-63, access through unique identifier and/or password; C9 L7-15, Fig.5A-6B user updates records by inputting new information, which is separately verified and added to the MVD).
25. As per Claim 15, Shapiro discloses wherein the applicant's invitation to view their respective personal profile is not sent from the applicant directly but from a third party automated e-mail processing system (C8 L57-67, C9 L1-31).
26. As per Claim 16, Shapiro discloses wherein the applicant's invitation to view their respective personal profile is viewable only through an email access link through a secure server. (C9 L24-31)

Art Unit: 3629

27. As per Claim 36, Shapiro discloses two non linked or connected data bases, one for input of identity verification data (Fig.5A-5B, registrant's file from storage) by applicant and one for creation and display of applicant's personal profile (Fig.5A-5B, completer Master Verification Document stored in master storage).
28. As per Claim 42 as understood by the examiner, Shapiro discloses wherein applicant's credit card is charged based on a membership level (C7 L22-30, service options and credit card payment information). (12)
29. As per **independent Claim 2**, Shapiro discloses a data processing system for verification of an individual's identification comprising: a. a computer for processing data (Fig.3); b. storage means for storing data on a storage system (Fig.2); c. first means for initializing the storage medium (Fig.2, Registration); d. second means for processing applicant's identification data (Fig.2, Verification process); e. third means for independently verifying the existence and accuracy of the applicant's identification data (Fig.2, Verification process; C6 L35-54); f. fourth means for sorting identification data into categories for applicant review (Fig.5A-5B, create Master Verification Document; C7 L58-65); g. fifth means for applicant to verify the accuracy the independent verification of applicant's identification data (Fig.6A, Registrant reviews MVD before dissemination); h. sixth means for applicant to challenge all or part of results of independent verification of identification data (Fig.6A, Registrant reviews MVD before dissemination); i. seventh means for applicant to create a personal profile from applicant's verified identification data (Fig.5A-5B, Master Verification document); j. eighth means for assignment of a unique identifier for the applicant's profile (Abstract); k. ninth means for applicant to issue invitation(s) to third parties to view applicant's profile; l. means

Art Unit: 3629

for third party to view applicant's personal profile (Abstract, registrant communicates access information to a third party).

30. As per Claims 17-24, Shapiro discloses wherein the computer processing means comprises a means for inputting and storing the applicant's profile information (Fig.2, Registrant data-entry process). Furthermore the structure described by Shapiro would have the capability to enter/store a multitude of profile information types; wherein the types of entered/stored profile information would merely be considered intended use of the claimed system.
31. As per Claim 28, Shapiro discloses wherein the sixth means comprises a template for applicants to create a personal profile for viewing by a third party, said template allowing the applicant to include or exclude identity verification data from the personal profile (C8 L49-53 registrant notes what portions of information to display and to whom).
32. As per Claim 29, Shapiro discloses wherein the seventh means comprises a template for applicants to create a personal profile for viewing by a third party, said template allowing the applicant to include or exclude data concerning the applicant's employment (C7 L32-36, template; C8 L49-53, registrant notes what portions of information to display and to whom).
33. As per Claim 30, Shapiro discloses wherein the eighth means comprises an electronically generated sequence of numbers and letters (C7 L30-32, computer assigns a unique alphanumeric number to the file; C7 47-49).
34. As per Claim 35, Shapiro discloses wherein the computer processing means further comprises a means for inputting and processing the applicant's credit card information for payment for use of the system (C7 L24-36).

Art Unit: 3629

35. As per **independent Claim 43**, Shapiro discloses a computer-readable medium encoded with instructions that cause a data processing system to perform a method comprising the steps of:

- a. entering identifying background information provided by the applicant (Fig.2, Registrant enters site and registers data); b. verifying the validity of applicant's the background information (Fig.2, Verification Process); c. sorting and categorizing the verified data for review by the applicant (Fig.5B, Master Verification Document created); d. transmitting the verified data to the applicant for accuracy (Fig.6A, Registrant reviews MVD before dissemination); e. creation of a personal profile by the applicant using the verified data (Fig.5A-5B, Master Verification document); f. assigning a unique identifier to the applicant's personal profile (Abstract); g. posting applicant's personal profile in a data base (Fig.5A-5B, Master Verification document); h. at applicants request, issuing invitation to third parties to view applicant's personal profile (Abstract, registrant communicates access information to a third party).

***Claim Rejections - 35 USC § 103***

36. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

37. **Claims 3-8, 13, 17, 25, 26, 34 and 37 are rejected under 35 U.S.C. 103 as being unpatentable over Shapiro.**

Art Unit: 3629

38. As per Claims 3-8 and 17, Shapiro does not expressly show wherein the background information comprises the applicant's: name (preferred and legal), date of birth, sex, social security number, citizenship, acknowledgement of any criminal convictions.
39. However these differences are only found in the nonfunctional descriptive data and are not functionally involved in the steps recited. The background verification method/system would be performed regardless of the type of user background information was collected/verified. Thus, this descriptive data will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).
40. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have collected/verified a multitude of user background information to include: name (preferred and legal), date of birth, sex, social security number, citizenship, acknowledgement of any criminal convictions, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.
41. As per Claim 13, while Shapiro does disclose wherein the applicant's personal profile can be modified to display all or some of the certain data types (C8 L49-53, registrant notes what portions of information to display and to whom), Shapiro does not expressly show wherein the applicant's personal profile can be modified to display all or some of the following data: felony convictions, misdemeanor convictions, employment verification, credit score, sexual offender classification, gender, drivers license possession, address, city of residence, state of residence, marital status, legal name, comments.

Art Unit: 3629

42. However these differences are only found in the nonfunctional descriptive data and are not functionally involved in the steps recited. The background verification method/system would be performed regardless of the type of verified user background information was modified or displayed. Thus, this descriptive data will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).
43. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified/displayed a multitude of verified user background information to include: felony convictions, misdemeanor convictions, employment verification, credit score, sexual offender classification, gender, drivers license possession, address, city of residence, state of residence, marital status, legal name, comments, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.
44. As per Claim 25, while Shapiro does disclose using an independent entity to verify the users information (C6 L35-54, C8 L15-40), Shapiro does not expressly show wherein the third means comprises an independent entity to verify the applicant's felony convictions, misdemeanor convictions, employment verification, credit score, sexual offender classification, gender, drivers license possession, address, city of residence, state of residence, marital status and legal name.
45. However these differences are only found in the nonfunctional descriptive data and are not functionally involved in the steps recited. The background verification method/system would be performed regardless of the type of user background information was verified by an

Art Unit: 3629

independent entity. Thus, this descriptive data will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

46. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have the independent entity verify a multitude of user background information to include: applicant's felony convictions, misdemeanor convictions, employment verification, credit score, sexual offender classification, gender, drivers license possession, address, city of residence, state of residence, marital status and legal name, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.
47. As per Claim 26, while Shapiro does disclose a database for storing/sorting data regarding applicant's verified information (Fig.2, C6 L51-54), Shapiro does not expressly show wherein the fourth means comprises a database for sorting data regarding applicant's credit data, any criminal convictions, employment, gender, drivers license possession, verification of residence address and marital status.
48. However these differences are only found in the nonfunctional descriptive data and are not functionally involved in the steps recited. The background verification method/system would be performed regardless of the type of verified user background information stored. Thus, this descriptive data will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Art Unit: 3629

49. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have stored a multitude of verified user background information to include: applicant's credit data, any criminal convictions, employment, gender, drivers license possession, verification of residence address and marital status, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.
50. As per Claim 34, while Shapiro does disclose applying a service mark to the verified profile of the applicant (C9 L26-40), Shapiro does not expressly show wherein the applied service mark comprises a PersonaCheck trademark.
51. However these differences are only found in the nonfunctional descriptive data and are not functionally involved in the steps recited. The background verification method/system would be performed regardless of the type of service mark applied to verified user background information. Thus, this descriptive data will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).
52. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have applied a multitude of service marks to the verified user background information to include: company trademarks or patent numbers, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.
53. As per Claim 37 as understood by the examiner, while Shapiro does disclose the ability of the registrant to note what portions of information to display and to whom (C8 L49-53),



Art Unit: 3629

Shapiro does not expressly show the notation "declined" as the response to any item which applicant chooses to exclude from their personal profile.

54. However these differences are only found in the nonfunctional descriptive data and are not functionally involved in the steps recited. The background verification method/system would be performed regardless of the type of notation used by the user to indicate any item which applicant chooses to exclude from their personal profile. Thus, this descriptive data will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).
55. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made for the user to use a multitude of notations to indicate any item which applicant chooses to exclude from their personal profile, to include the notation "declined", because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.
56. **Claims 10, 11, and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shapiro et al. (US 6,714,944 B1) in view of Austin et al. (US 2004/0128148 A1).**
57. As per Claim 10, while Shapiro does disclose receiving verification information from third-party sources (Shapiro C8 L19-29), Shapiro fails to expressly disclose wherein pertinent credit data is sorted into fields of "Good", "Fair" "Poor" and "Challenged" as defined by the financial credit scores obtained.
58. However, Austin discloses verifying user background information to include credit (credit score) information (Austin Fig.7, Para 0032); furthermore, official notice is given that credit

Art Unit: 3629

scores were routinely categorized in grouping such as "Good", "Fair" "Poor" and "Challenged", based on the reported credit score.

59. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included wherein pertinent credit data is sorted into fields of "Good", "Fair" "Poor" and "Challenged" as defined by the financial credit scores obtained, as disclosed by Austin in the system disclosed by Shapiro, for the advantage of providing a method for verification of an individual's identity, with the ability to increase the effectiveness/customer service of the method by compiling and displaying verified information in a user friendly format.
60. As per Claim 11, Shapiro fails to expressly disclose wherein Felony and Misdemeanor data found during verification is reflected by a "positive hit" without regard to the specific details of the data.
61. However, Austin discloses verifying user background information to include criminal history information and displaying an indication of the data found for the user (Fig.7); furthermore the type of indication ("positive hit") would only be found in the nonfunctional descriptive data and would not functionally be involved in the steps recited.
62. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included wherein Felony and Misdemeanor data found during verification is reflected by a "positive hit" without regard to the specific details of the data, as disclosed by Austin in the system disclosed by Shapiro, for the advantage of providing a method for verification of an individual's identity, with the ability to increase the

effectiveness/customer service of the method by compiling and displaying verified information in a user friendly format.

63. As per Claim 32, Shapiro fails to expressly disclose wherein the seventh means further comprises a digitized photograph submitted by the applicant.

64. However, Austin discloses verifying user background information and displaying a full user profile, to include a digitized photograph submitted by the applicant (Fig.5, Para 0029).

65. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included wherein the seventh means further comprises a digitized photograph submitted by the applicant, as disclosed by Austin in the system disclosed by Shapiro, for the advantage of providing a method for verification of an individual's identity, with the ability to increase the effectiveness/customer service of the method by compiling and displaying a multitude of profile information for the outside examination of the verified user.

66. **Claims 33, and 39-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shapiro et al. (US 6,714,944 B1) in view of Rosen (US 2004/0186852 A1).**

67. As per Claim 33, Shapiro discloses wherein the eighth means further comprises an automated email system operated on a server without direct access between the applicant and the third party/invitee (C8 L57-67, C9 L1-31).

68. However, Shapiro fails to expressly disclose a secure server.

69. Official notice is given that secure servers were well known and used at the time the invention was made, especially for web-commerce systems.

Art Unit: 3629

70. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included a secure server in the system disclosed by Shapiro, for the advantage of providing a method for verification of an individual's identity, with the ability to increase the effectiveness/customer service of the method by ensuring the security of the potentially private information provided by the user to be verified.
71. Furthermore, Shapiro fails to expressly disclose a time limit for which the applicant's profile may be viewed.
72. Rosen discloses placing limitations on verified profiles viewed by employers (third-party), to include a one-time use limitation (Para 0132).
73. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included a time limit for which the applicant's profile may be viewed, as disclosed by Rosen in the system disclosed by Shapiro, for the advantage of providing a method for verification of an individual's identity, with the ability to increase the effectiveness/efficiency of the method by maintaining strict guidelines (time and distribution) on the third-party use of the provided verified information.
74. As per Claim 39, Shapiro fails to expressly disclose a single access to applicant's personal profile by a third party.
75. Rosen discloses placing limitations on verified profiles viewed by employers (third-party), to include a one-time use limitation (Para 0132).
76. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included a single access to applicant's personal profile by a third party, as disclosed by Rosen in the system disclosed by Shapiro, for the advantage of

Art Unit: 3629

providing a method for verification of an individual's identity, with the ability to increase the effectiveness/efficiency of the method by maintaining strict guidelines (time and distribution) on the third-party use of the provided verified information.

77. As per Claim 40, Shapiro fails to expressly disclose wherein applicant's identification information self-report is verified using a credit reporting service.

78. However, Rosen discloses wherein applicant's identification information self-report is verified using a credit reporting service (Para 0230).

79. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included wherein applicant's identification information self report is verified using a credit reporting service, as disclosed by Rosen in the system disclosed by Shapiro, for the advantage of providing a method for verification of an individual's identity, with the ability to increase the effectiveness of the method by verifying user information with information compiled at reputable sources.

80. As per Claim 41, Shapiro discloses wherein applicant's criminal history if any is verified using a criminal conviction database service.

81. However, Rosen discloses wherein applicant's criminal history if any is verified using a criminal conviction database service (Para 0230-0234).

82. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included wherein applicant's criminal history if any is verified using a criminal conviction database service, as disclosed by Rosen in the system disclosed by Shapiro, for the advantage of providing a method for verification of an individual's

Art Unit: 3629

identity, with the ability to increase the effectiveness of the method by verifying user information with information compiled at reputable sources.

83. **Claims 27, 31 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shapiro.**

84. As per Claim 27, Shapiro discloses wherein the fifth means comprises a data link with access restricted to applicants allowing applicant to verify or challenge the accuracy of their identity verification data (C6 L21-34, Internet; C9 L7-23, registrant can review the MVD before dissemination).

85. However, Shapiro fails to expressly disclose a secure data link.

86. Official notice is given that secure data links were well known and used at the time the invention was made, especially for web-commerce systems.

87. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included a secure data link in the system disclosed by Shapiro, for the advantage of providing a method for verification of an individual's identity, with the ability to increase the effectiveness/customer service of the method by ensuring the security of the potentially private information provided by the user to be verified.

88. As per Claim 31, Shapiro discloses wherein the ninth means comprises an automated email system operated on a server without direct access for link between the applicant and the third party/invitee (C8 L57-67, C9 L1-31).

89. However, Shapiro fails to expressly disclose a secure server.

90. Official notice is given that secure servers were well known and used at the time the invention was made, especially for web-commerce systems.

91. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included a secure server in the system disclosed by Shapiro, for the advantage of providing a method for verification of an individual's identity, with the ability to increase the effectiveness/customer service of the method by ensuring the security of the potentially private information provided by the user to be verified.
92. As per Claim 38 as understood by the examiner, Shapiro discloses wherein the applicant's verification or challenge to applicant's verified identification data is conducted via an Internet server link (C6 L21-34, Internet; C9 L7-23, registrant can review the MVD before dissemination).
93. However, Shapiro fails to expressly disclose a secure server link.
94. Official notice is given that secure server links were well known and used at the time the invention was made, especially for web-commerce systems.
95. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included a secure server link in the system disclosed by Shapiro, for the advantage of providing a method for verification of an individual's identity, with the ability to increase the effectiveness/customer service of the method by ensuring the security of the potentially private information provided by the user to be verified.

### *Conclusion*

96. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Art Unit: 3629

97. The following foreign patent is cited to show the best foreign prior art found by the examiner:

**PCT No. WO 200133421 A1 to Gibbs et al.**

Gibbs discloses a candidate profile creating system for assisting a candidate in obtaining employment, which has modules for testing candidate skills, obtaining background checks, and training the candidate for interviews.

98. The following non-patent literature is cited to show the best non-patent literature prior art found by the examiner:

**Backgrounds Online (www.backgroundsonline.com, Retrieved from Internet Archive Wayback Machine <www.archive.org>, Date Range: 4/27/1999-10/6/2000)**

Backgrounds Online disclose a system for providing background checks for employer/candidates online.

99. Additional Literature has been referenced on the attached PTO-892 form, and the Examiner suggests the applicant review these documents before submitting any amendments.

100. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Ouellette whose telephone number is (571) 272-6807. The examiner can normally be reached on Monday through Thursday, 8am - 5:00pm.

101. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone numbers for the

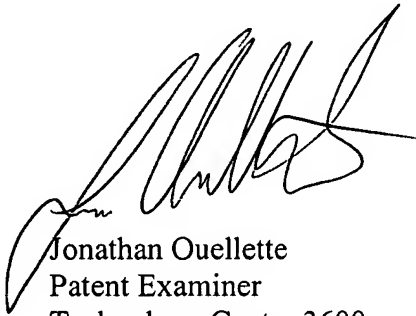


Art Unit: 3629

organization where this application or proceeding is assigned (703) 872-9306 for all official communications.

102. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-5484.

May 16, 2005



Jonathan Ouellette  
Patent Examiner  
Technology Center 3600